

# Notice of Allowability

## Application No.

09/965,766

## Examiner

Evelyn Huang

## Applicant(s)

MEISSNER ET AL.

## Art Unit

1625

### -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed on 7-29-2004.
2. ☒ The allowed claim(s) is/are 4-6, 10-12, 22-24 and 28-35.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                       |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                               |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance              |
|   | 9. <input type="checkbox"/> Other _____.  |

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***EXAMINER'S AMENDMENT***

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Witkowski on 10-6-2004. During the interview, the examiner suggested deleting the non-elected claims 16-18 to place the application in conditions for allowance.

The application has been amended as follows:

Cancel claims 16-18 without prejudice to filing of divisional applications.

***REASONS FOR ALLOWANCE***

2. The following is an examiner's statement of reasons for allowance:

Claims 4-6, 10-12, 22-24, 28-35 are allowed.

The rejection for Claims under 35 U.S.C. 103(a) as being obvious over Banholzer I (5770738) or Banholzer II (5654314, which has the same parent as 5770738), which are the US equivalents of WO 92/16528 (PTO-1449)) and the corresponding obviousness type double patenting rejection is withdrawn in view of the amendment to the allowable compound wherein both phenyls are substituted by fluoro, chloro or bromo in view of the Declaration showing an unexpectedly shorter duration of action of the instant compound (wherein both phenyls are substituted by fluoro) over the compound of Banholzer (wherein both phenyls are unsubstituted). The instant compound therefore would fit in the pharmacological profile necessary for a once-a-day drug, whereas the compounds of Banholzer having an extremely long duration of action would not be useful for a once-a-day mode of administration.

The rejection under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is rendered moot by the cancellation of claims 19-21 and the amendment of claims 22-24 to method of treating COPD.

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The enablement rejection for Claims 19-30 under 35 U.S.C. 112, first paragraph is withdrawn in view of the amendment to the method for treating asthma or COPD, spasm in the gastrointestinal tract or spasm in the urinary tract. The claims as amended are now commensurate in scope with that of the objective enablement.


The rejection under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 11-24 of U.S. Patent No. 6706726 (Application No. 09/976950) in view of Banholzer (WO 92/16528, PTO-1449) is withdrawn in view of the amendment limiting R3 and R5 to be fluorine, chlorine or bromine and R4, R6-R8 to be hydrogen, fluorine, chlorine or bromine. The closest patented compound (claim 5, wherein R3-R6 are hydrogen or fluorine) additionally has fluorine instead of the instant hydroxy as R7. The interchangeability of fluorine and hydroxy is not taught or suggested by the patent or by Banholzer. Motivation to modify the patented compound to arrive at the instant is lacking.

3. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 571-272-0686. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Evelyn Huang  
Primary Examiner  
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